

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	MAIL STOP
Shinichi Takagi et al.)	Group Art Unit: 2823
Application No.: 09/987,153)	Examiner: SHEILA V CLARK
Filed: November 13, 2001)	Confirmation No.: 6439
For: SEMICONDUCTOR ELEMENT)	
MODULE AND SEMICONDUCTOR)	
DEVICE WHICH PREVENTS)	
SHORT CIRCUITING)	

09/14/2009

CONSIDERED: /S.C./

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is being filed in response to new points of argument raised in the Examiner's Answer dated June 12, 2009.

In responding to the arguments presented in Appellants' main brief, the Answer relies upon the three-step test for recapture that is set forth in MPEP §1412.02, which is reiterated on page 5 of the Answer. In doing so, however, the Answer does not properly apply the third step of that test, namely "determining whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule." This particular step is discussed in MPEP § 1412.02, subsection I.C. This subsection states that there are two different types of analysis that must be performed to determine whether recapture exists. The first analysis is to compare the reissue claim to any claims cancelled or amended during prosecution. Recapture bars any reissue claim that is as broad or broader in scope than a claim that was cancelled or amended in the original prosecution to define over the prior art. See, e.g. *Ex Parte*